



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appn. Number: 10/008,667
Appn. Filed: 11/03/01
Applicant: Iram Casas
Title: Lighting Apparatus for Tools
Examiner: Bertrand Zeade/2875

RECEIVED
FEB 21 2003
41 Response
A. Darnell
2/25/03

In response to the Office Action mailed out on November 20, 2002, please make the following amendments and note the following remarks:

REMARKS

Examiner's first rejection:

The Examiner has rejected claims 1, 4, and 5 as being clearly anticipated under 35 U.S.C. 102(b) based on Gible (US 2,855,679). Applicant disagrees with this rejection as indicated below.

First and foremost, the applicant notes that one of the elements, specifically element 1(d) of claim 1, states "mounting means for attaching the casing to the hand-held tool." It should be noted that although the Gible prior art reference does disclose a casing and light combination, the casing is attached within the hand-held tool and is not attached to the hand-held tool. Therefore, one of the elements disclosed in the present invention is missing within the Gible prior art reference, and thus, applicant believes he has successfully traversed this rejection.

Since claims 4-5 are derivative of claim 1 either directly or indirectly, the above-listed legal reasoning and analysis is believed to obviate this rejection for these claims as well.

Examiner's second rejection:

The Examiner has rejected claims 2-3 under 35 U.S.C. 103(a) based on Gibble (US 2,855,679) in view of Snoke et al. (US 5,797,670). Applicant disagrees with this rejection as indicated below.

Even if the two prior art references were combined as the Examiner has indicated, all of the claimed elements of the present invention would not be disclosed. As is clear from the specification and the accompanying claims, element 1(d) of claim 1, states "mounting means for attaching the casing to the hand-held tool." It should be noted that although the Gibble prior art reference does disclose a casing and light combination, the casing is attached within the hand-held tool and is not attached to the hand-held tool. Therefore, one of the elements disclosed in the present invention is missing within the Gibble prior art reference. Applicant propounds it would not be "obvious" to automatically change the location of the casing and light combination to arrive at the present invention.

Examiner's third rejection:

The Examiner has rejected claim 6 under 35 U.S.C. 103(a) based on Gibble (US 2,855,679) in view of Gassen et al. (US 5,016,355). Applicant disagrees with this rejection as indicated below.

Even if the two prior art references were combined as the Examiner has indicated, all of the claimed elements of the present invention would not be disclosed. As is clear from the specification and the accompanying claims, element 1(d) of claim 1, states "mounting means for attaching the casing to the hand-held tool." It should be noted that although the Gibble prior art reference does disclose a casing and light combination, the

casing is attached within the hand-held tool and is not attached to the hand-held tool. Therefore, one of the elements disclosed in the present invention is missing within the Gibble prior art reference. Applicant propounds it would not be "obvious" to automatically change the location of the casing and light combination to arrive at the present invention.

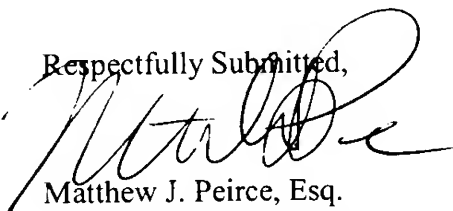
Furthermore, the mere existence of a chain saw, as disclosed in the Gassen et al., would not be enough to automatically render the resulting combination in the present invention, as disclosed in claim 6, "obvious." If this reasoning were upheld on this basis, each element of a particular claim for any application could merely be "picked out" of a different prior art reference, with the resulting combination declared obvious due to prior disclosure of each separate element. This type of analysis is inappropriate when looking at claims "as a whole."

CONCLUSION

For all of the above-described reasons, applicant submits that the specifications and claims are now in proper form, and that the claims define patentability over the prior art. In addition, applicant believes that his arguments in the "Remarks" section successfully traverses the objections and rejections brought forth by the Examiner in the Office Action. Therefore, the applicant respectfully submits that this application is now in condition for allowance, which action he respectfully solicits. If the Examiner feels that some of the dependent claims are allowable, the Applicant asks the Examiner to

allow the Applicant to make any amendments to the allowed claims to incorporate all the limitations of the base claim and any intervening claims.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Matthew J. Peirce', written over the typed name.

Matthew J. Peirce, Esq.

Registration No. #41,245

Attorney for Inventor Iram Casas